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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
In re Application of:) Art Unit:
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THOM, et al.) Examiner:
)
Serial No.: 09/913,944) Washington, D.C.
)
Filed: December 19, 2001) March 12, 2004
)
For: BIOCOMPATIBLE MATERIAL) Docket No.: THOM=1
WITH A NOVEL)
FUNCTIONALITY) Confirmation No.: 5897

PETITION UNDER 37 CFR §§1.8 AND 1.181 TO
VACATE ERRONEOUS HOLDING OF ABANDONMENT

PCT Legal Office
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop PCT
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

Applicants hereby petition under 37 CFR §§1.8 and 1.181 that the erroneous holding of abandonment be withdrawn and the enclosed amendment, and enclosures, originally filed December 19, 2001, be entered nunc pro tunc.

Statement of Facts

1. On October 19, 2001, the PTO mailed a Notice to File Missing Parts to the former attorneys of record, who were with the law firm Skadden, Arps, Slate, Meagher & Flom LLP.
2. On December 19, 2001, applicants responded to that notice. The response included a certificate of mailing under rule 1.8 signed by Josephine Hardy then a Legal Assistant at that firm.
3. On August 28, 2003, the undersigned filed an IDS, acting in a representative capacity. On October 3, 2003, the undersigned filed a substitute power of attorney, thereby becoming attorney of record.
4. On January 21, 2004, the undersigned filed a request for status.
5. In the week of February 23, 2004, the undersigned

received a telephone call from a "Ms. Louis" of the PTO, who advised him that the case was "abandoned 6/19/03 incomplete pre-exam".

6. On March 3, 2004, Valerie Conard and Mark Ragland of the PTO both advised Counsel that there was no record in PALM of the December 19, 2001 response.

7. On March 8, 2004, PCT Legal Examiner Boris Milef advised counsel that the response was not physically in the official file.

8. On March 8, 2004, counsel drafted a declaration for execution by Josephine Hardy and faxed it to Skadden, Arps. The executed declaration was received on March 11.

Argument

37 CFR Rule 1.8(b) provides

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence

was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The December 19, 2001 response was transmitted in accordance with 37 CFR §1.8(a).

We orally informed the PTO of the previous mailing on the very day (March 3) that we became aware of the lack of evidence of receipt in PALM. This petition informed the PTO in writing of this situation less than two weeks later.

With this petition, we supply an additional copy of the previous response, including the certificate of mailing.

We also enclose the declaration of Josephine Hardy, which attests on a personal knowledge basis to the previous timely mailing.

We also enclose a copy of a December 20, 2001 letter, signed by Josephine Hardy, which reported the filing of the response to Jesper Levin Aamand of Hoiberg ApS.

It is believed that no fee is due for a petition of this nature. However, if we are mistaken, please charge the fee to Deposit Account 02-4035, and notify the undersigned.

Respectfully submitted,

BROWDY AND NEWMARK, P.L.L.C.
Attorneys for Applicant

By: 

Iver P. Cooper
Reg. No. 28,005

Enclosures

- 1) December 19, 2001 response and 1.63 declaration
 - 2) Hardy declaration
 - 3) Hardy letter
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Washington, D.C. 20001
Telephone: (202) 628-5197
Facsimile: (202) 737-3528
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